



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,018	02/05/2001	Roger N. Hastings	5236-000215	5479

7590 10/19/2004

Harness, Dickey & Pierce
Suite 400
7700 Bonhomme
St. Louis, MO 63105

EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
----------	--------------

3743

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,018

Applicant(s)

HASTINGS ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

This is a response to the amendment dated August 18, 2004. Claims 34-42 are under consideration. It is noted that the serial number at the bottom of the amendment do not match that of the instant application. Further, it is noted that applicant has not addressed the double patenting rejections. They are reiterated below.

Response to Arguments

1. Applicant's arguments filed August 18, 2004 have been fully considered but they are not persuasive.

Applicant argues the obviousness rejections of claims 34, 35 and 39. Regarding claims 34 and 35, applicant states, it would not be obvious to provide optical conduits that are rotatable within the support structure at the distal end. However, the current application specification on page 7 states, "*The catheter 402 can be rotated, or the individual optical fibers 420 and 422 can be rotated to imaging substantially the entire (and preferably the entire) interior circumference of the vessel in which the device is located.*" It appears from the specification that rotating the catheter and rotating the fibers are equivalents. Thus, it would be obvious to obtain rotation via any method and it would be obvious to one with ordinary skill in the art to rotate the individual fibers. Moreover, Pitris et al. (US Patent No. 6,564,087) have been cited below to demonstrate one of a mere plethora of rotating fibers. Applicant has failed to claim structural features to define over the prior art.

Regarding claim 39, applicant argues rotating magnetic members is an unobvious design choice. However, the examiner respectfully disagrees. Abela et al. (US 5,769,843) a previously cited reference is a mere example of the plethora of examples of rotating

Art Unit: 3743

magnets (see column 10, lines 45-55). Further, having rotatable magnet members would be obvious to one with ordinary skill in the art. Applicant has failed to claim structural features to define over the prior art. The rejection is made final and reiterated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponzi in US Patent No. 5,964,757.

Regarding claims 34 and 35, Ponzi discloses a catheter (12) having a proximal and distal end and a lumen (18) therebetween; a support structure (19/36/14) in the lumen adjacent the distal end; one or more energy/optical conduits (such as 46, etc.) in the catheter, each having a distal end supported by the support structure (19/36); and one or more magnet members (such as 72 with 36 and 38) disposed in the distal end of the

Art Unit: 3743

catheter, as recited throughout the specification with emphasis on column 9, and see in figures 2A-8.

However, Ponzi does not explicitly recite an energy/optical conduit distal end that is rotatable within the support structure and/or catheter. On the other hand, it would be obvious to one with ordinary skill in the art to modify the invention of Ponzi to include rotation for the purpose of increased flexibility to the system.

Regarding claim 36, Ponzi as modified discloses that as applied to claim 35, as well as, a support structure (19/14/36) that has one or more magnet members (such as 72, etc.), as recited in columns 9-10.

Regarding claim 37, Ponzi as modified discloses that as applied to claim 36, as well as, a support structure (19/14/36) that is a sheath, as seen in figures 1-8.

Regarding claim 38, Ponzi as modified discloses that as applied to claim 37, as well as, a support structure that has an ablation tool (46), as recited in column 8, lines 10-20.

Regarding claim 39, Ponzi discloses a catheter (12) having a proximal and distal end and a lumen (18) therebetween; a support structure (19/36/14) in the lumen adjacent the distal end; one or more energy/optical conduits (such as 46, etc.) in the catheter, each having a distal end supported by the support structure (19/36); and one or more magnet members (such as 72 with 36 and 38) disposed in the distal end of the catheter, as recited throughout the specification with emphasis on column 9, and see in figures 2A-8.

Art Unit: 3743

However, Ponzi does not explicitly recite one or more magnet members that are positioned in the wall of the catheter. On the other hand, the magnet members of Ponzi are positioned in the wall of the tip, which can be considered an equivalent.

Regarding claim 40, Ponzi as modified discloses that as applied to claim 39, as well as, an ablation member (46) at the catheter distal end, as seen in figures 1-8.

Regarding claim 41, Ponzi as modified discloses that as applied to claim 40. However, Ponzi does not recite one or more magnet members that are comprised by the support member. The electrode tip of Ponzi has the ablation laser and is considered an equivalent given the disclosure in the current specification.

Regarding claim 42, Ponzi as modified discloses that as applied to claim 41, as well as, a support structure that has a passage (78) for a guidewire, as recited in column 11, lines 65-67

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3743

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 27-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-7, and 20 of copending Application No. 09/352,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely reworded representations of the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,564,087.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KO


Henry A Bennett
Patent Examiner
Group 3700